

REMARKS

Applicant added new claims 83-88 that further define the visibility aspects of claim 1.

Applicant traverses the latest restriction requirement made by the examiner.

Previously added claims 56-82 were restricted by the examiner based on "original presentation."

Claims 56-62 and 80-82 depend directly or indirectly on claim 1 or claim 10 and further define and limit elements of claims 1 and claim 10. Claims 63-79 are a set of claims directed to the features of claims 1 and certain of the dependent claims of claim 1 expressed as a computer program product.

Restriction of these claims is improper, since all of these claims are consonant with the original restriction requirement, as claims directed to the general field of "controlling utilization of data." These claims either further define the features of the elected invention or express the elected invention in a different statutory class. Applicant is not aware of any Office regulation, prohibiting Applicants to have claims to more than one statutory class in an application and the examiner has not shown that claims in the different classes are independent and distinct or directed to species, genus or directed to a patentable distinct combination, sub-combination.

According to the provisions of MPEP 821, the examiner should clearly set forth in the Office Action the reasons why these claims withdrawn from consideration are not readable on the elected invention. The examiner has not done this. Under MPEP and 821.03, the examiner still must show that the added claims are to a different invention.

Applicant will treat the withdrawn claims as pending in the case, pending final determination by the examiner to allow applicant to file a petition to the commissioner.

Applicant notes that in the rejections below, the examiner has included the restricted claims.

The examiner rejected claims 1 and 63 as indefinite as directed to a single step claim, as incomplete and failing to recite any steps of notifying.

Applicant disagrees that the precedence cited by the examiner, pertaining to means clauses, is applicable to method and computer program product claims. Claims 1 and 63 have been amended to overcome this rejection and to advance prosecution of this case. Applicant has

also overcome the remaining indefiniteness rejections by amending claim 1 to recite sending information on topics of interest stored on distributed databases ... and notifying the user of a match in the information.

The examiner rejected claims 1-14, 26-28, 58, 61, 63-71, 74, 77, and 79-82 under 35 U.S.C. 102(a) as being anticipated by Tso (U.S. Patent 6,047,327).

As amended, claim 1 is distinguished over Tso. Claim 1 now recites ... dynamically matching information on topics of interest stored on distributed databases with user information stored in a device, according to visibility settings in the information received and visibility settings in the information stored in the device, and notifying the user of a match in the information. These amendments are supported throughout applicant's specification. For instance, support can be found on page 16 lines 8-12; FIG. 6A, item 120a; FIG. 19 and pages 23-24

Tso does not teach these features of claim 1. Rather, Tso teaches at Col. 4 line 39-41:

The records containing each user's information is stored on a subscriber database at the user's home InfoCast server, as described below. Alternatively, user information may also be stored or replicated at other locations on the connected network, also as described below.

Nowhere does Tso suggest matching information on topics of interest with user information stored in a device.

Further, to protect how and to whom information is shared, Applicant includes visibility settings in the information received and visibility settings in the information stored in the device to determine whether a match is possible or not. Tso does not suggest this feature in step 205 of FIG. 7 or elsewhere. Using a random percentage function is not a visibility setting, as claimed and described by Applicant. Rather, as discussed at Col. 22, line 59-67, Tso states:

In Block 205, after the InfoBite is processed, a random percentage between 0% and 100% is generated for each user to

provide a chance for the InfoBite to be sent to users who were not sent the InfoBite during the operation of Block 203.

Generating the random percentage provides a chance that a user, who was not sent an InfoBite, would be sent such data. These teachings have nothing at all to do with the visibility settings in the information received and visibility settings in the information stored in the user device, as now recited in claim 1.

Claim 63 which is directed to a computer program product and contains similar limitations as claim 1 is also allowable over Tso. Similarly, claims 2-9, 56-58, 61-62, which depend directly or indirectly on claim 1 and claims 64-78, which depend directly or indirectly on claim 63 are allowable over Tso.

Claim 10 as amended calls for instructions to *** wrap content with control information *** with the control information further comprising fields for setting visibility settings in the information, the visibility settings determining how content information is made available to other devices. At least for the reasons discussed above, claim 10 is allowable over Tso. Further dependent claims 11-14, 59-60 and 79-82, which depend directly or indirectly on claim 10, are allowable at least for the reasons discussed in claim 10.

Claim 26, as amended, calls for a *** matching process that matches information sent as a capsule with a wrapper from a client with information *** comprising matching wrapper information from a received capsule. Claim 26 specifies that the wrapper information includes control information that determines how to use the information content of the capsule with other capsules of information. Claim 26 also specifies that the control information includes fields for setting visibility settings in the information with the visibility settings controlling how the information is made available to other devices.

Claims 27 and 28 which depend on claim 26 are allowable at least for the reasons discussed in claim 26.

The examiner rejected claims 1-4, 6-12, 58, 63-66, 68-71, 74, 79, and 80-82 under 35 U.S.C. 102(a) as being anticipated by Leonard et al. (U.S. Patent 6,721,784).

Claim 1 is distinct over Leonard, since Leonard neither describes nor suggests dynamically matching information on topics of interest stored on distributed databases with user information stored in a device, according to visibility settings in the information received and visibility settings in the information stored in the device.

Leonard does not suggest these features of claim 1. Rather, Leonard describes an e-mail system where the originator of the message can select a time, date, etc. at which all incarnations of the message will self-destruct. However, in that system Leonard does not match information on topics of interest with user information in the device. Leonard also does not discuss that matching is performed according to visibility settings in the information received and visibility settings in the information stored in the device. Thus, claim 1 is distinct over Leonard.

Claim 63, which is directed to a computer program product, and contains similar limitations as claim 1 is also allowable over Leonard. Similarly, claims 2-4, 6-9, and 58, which depend directly or indirectly on claim 1 and claims 63-66, 68-71, 74, which depend directly or indirectly on claim 63 are allowable over Tso.

Claim 10, as amended, calls for instructions to *** wrap content with control information *** with the control information further comprising fields for setting visibility settings in the information, the visibility settings determining how content information is made available to other devices. At least for the reasons discussed above, claim 10 is allowable over Leonard. Further dependent claims 11, 12 and claims 79, and 80-82 are also allowable.

The examiner rejected claims 26-28 under 35 U.S.C. 103(a) as being obvious over Tso (U.S. Patent 6,047,327).

Claim 26, as discussed above now calls for a matching process that matches information sent as a capsule with a wrapper from a client with information. Claim 26 specifies that the wrapper information includes control information that determines how to use the information content of the capsule with other capsules of information. Claim 26 also specifies that the control information includes fields for setting visibility settings in the information with the visibility settings controlling how the information is made available to other devices.

The examiner indicated that:

***matching or filtering capsule or any form of data packages at any locations, such as at a server or a client, would have been obvious to one of ordinary skilled in the art at the time of the invention was made that was a matter of desirable implementation choice, which produce the same result of filtering specific information based on information contained it the capsule of Infobite or the like (office action page 6)

In view of the amendment to claim 26, applicant believes that claim 26 is allowable. Tso does not suggest the visibility settings and does not suggest to match based on the visibility settings. Claims 27 and 28 which depend on claim 26 are allowable at least for the reasons discussed in claim 26.

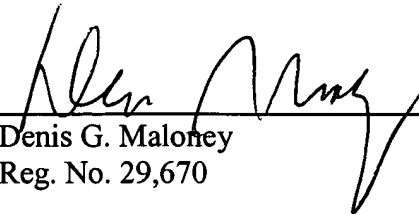
The fact that the applicant has addressed certain comments of the examiner does not mean that the applicant concedes any other positions of the examiner. The fact that the applicant has asserted certain grounds for the patentability of a claim does not mean that there are not other good grounds for patentability of that claim or other claims.

Enclosed is a \$55 check for the Petition for Extension of Time fee. No fee is believed due for the added claims. However, if a fee is due, please apply that fee or any other charges or credits to deposit account 06-1050 referencing the above attorney docket number.

Respectfully submitted,

Date: _____

9/9/04



Denis G. Maloney
Reg. No. 29,670

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906